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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/428,036
Filing Date: October 27, 1999
Appellant(s): NEWTON ET AL.

MAILED

APR 0 6 2005

Technology Center 2600

Ralph E. Jocke
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/15/04.

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-45 do not stand or fall together and

provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,502,944	Kraft et al.	4-1996
5,036,462	Kaufman et al.	7-1991
5,797,515	Liff et al.	8-1998

5,301,105   Cummings, Jr.   4-1994

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2.   Claims 1, 10-23, 26 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by

U.S. Patent No. 5,502,944 to Kraft et al.

As per claim 1, Kraft et al. teaches method comprising the step of:

(a) the claim storing in at least one data store in operative connection with at least one

computer, data representative of at least one patient and at least one medical item prescribed for

use by the patient is met by storing information concerning a patient's medication requirements

on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59);

(b) the claimed storing in the data store, data representative of a plurality of holding

locations for medical items in a medical item dispenser, a plurality of types of medical items, and

for each of the storage locations, a type medical item stored in the respective storage location is

met by the pharmacy computer system that maintains a database of the medication, the

manufacturer, the brand name, the generic name, the dosage form, the location of the drug in the

pharmacy, and pricing information (see: column 1, lines 29-34);

(c) the claimed inputting through an input device in operative connection with the

computer and the dispenser, data corresponding to the patient is met by keyboard (28, Fig. 2);

(d) the claimed dispensing from the dispenser responsive to the data stored in the data

store, the type medical item prescribed for use by the patient, wherein the type medical item in

dispensed from a storage location holding the type medical item in the dispenser is met by the

dispensing process where the nurse enter commands through the system controller (34, Fig. 3) to

retrieve medication for one or more patients (see: column 4, lines 54-56);

(e) the claimed including in the data store responsive to execution of step (d), data

representative that the type medical item has been dispensed for use by the patient, and that the

type medical item has been dispensed from the dispenser is met once the nurse orders all or part

of the authorized medication for each of the nurse's patients for a given medication round, the

medication dispenser (12, Fig. 1) retrieves each medication from its respective container and

dispenses the medication (see: column 4, lines 60-65).

As per claim 10, Kraft et al. teaches the claimed step (d) further comprising the step of

displaying on an output device adjacent to the dispenser, display indicia including indicia

indicative of the type medical item. This feature is met by the video display (26, Fig. 2) and

printer (30, Fig. 2) connected to the medication dispenser (see: column 4, lines 3-15 and Fig. 2).

As per claim 11, Kraft et al. teaches prior to step (d) further comprising the step of

receiving an input through an input device indicating agreement with the display indicia. The

dispensing process meets this feature where the nurse enters commands through the system

controller (34, Fig. 3) using a keyboard (28, Fig. 2) connected to the medication dispenser (see:

column 4, lines 54-56).

As per claim 12, Kraft et al. teaches prior to step (a), inputting through a physician

terminal in operative connection with the computer, prescription data representative of

information that the medical item has been prescribed for the patient, and a medical condition for

which the medical item has been prescribed, wherein in step (a) the data stored includes

prescription data, and wherein in the displaying step the display indicia includes indicia

indicative of the medical condition. The dispensing process meets this limitation where the nurse

enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) and

video display (26, Fig. 2) connected to the medication dispenser (see: column 4, lines 54-56).

The information concerning the patient medication requirement is stored in the pharmacy system

(14, Fig. 1) and when the medication package given to the patient include a label with

information such as patient's name, room number, doctor's name and other data as required (see:

column 4, lines 60 to column 5, lines 2).

As per claims 13-14, Kraft et al. teaches a dispensing process where the nurse enters

commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display

(26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4,

lines 54-56). The information concerning the patient medication requirement is stored in the

pharmacy system (14, Fig. 1) and when the medication package given to the patient include a

label with information such as patient's name, room number, doctor's name and other data as

required (see: column 4, lines 60 to column 5, lines 2).

As per claim 15, Kraft et al. teaches each individual medication package given to a

patient is labeled with information including type of medication and dosage size (see: column 4,

line 66 to column 5, line 7).

As per claim 16, Kraft et al. teaches a medication dispensing system that storing

information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1)

(see: column 4, lines 56-59). Kraft et al. further teaches a dispensing process where the nurse

enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video

display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see:

column 4, lines 54-56). The information concerning the patient medication requirement is stored

in the pharmacy system (14, Fig. 1) and when the medication package given to the patient

include a label with information such as patient's name, room number, doctor's name and other

data as required (see: column 4, lines 60 to column 5, lines 2). In addition, Kraft et al. teaches a

dispensing process where the nurse enters commands through the system controller (34, Fig. 3)

using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: column 4, lines

54-56).

As per claims 17 and 18, Kraft et al. teaches each individual medication package given to

a patient is labeled with information including type of medication and dosage size (see: column

4, line 66 to column 5, line 7).

As per claim 19, Kraft et al. teaches prior to the applying step of printing a prescription

label, wherein the prescription label includes the indicia indicative of the data included in the

prescription data, wherein in the applying step the label is applied in connection with the type

medical item (see: column 4, line 66 to column 5, line 7).

As per claims 20 and 21, Kraft et al. teaches applying the step of executing the prior to

step (d), wherein the indicia indicative of data included in prescription data is applied to the type

medical item to be dispensed in step (d). This feature is met by each medication package for a

given patient are labeled with information including patient's name, room number, doctor's

name and other data as required (see: column 4, lines 60 to column 5, lines 2).

As per claim 22, Kraft et al. teaches a label printer coupled to the controller for printing a

patient prescription label for attaching to a dispensed pharmaceutical package. The limitation is

met by the medication package subsystem using the printing module (300, Fig. 24) including

printheads (320, Fig. 24) for printing directly to package material (see: column 12, lines 22-45).

As per claim 23, Kraft et al. teaches a medication dispensing system that storing

information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1)

(see: column 4, lines 56-59). Kraft et al. further teaches a dispensing process where the nurse

enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video

display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see:

column 4, lines 54-56). The information concerning the patient medication requirement is stored

in the pharmacy system (14, Fig. 1) and when the medication package given to the patient

include a label with information such as patient's name, room number, doctor's name and other

data as required (see: column 4, lines 60 to column 5, lines 2). In addition, Kraft et al. teaches a

dispensing process where the nurse enters commands through the system controller (34, Fig. 3)

using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: column 4, lines

54-56).

As per claim 26, Kraft et al. teaches a dispensing process where the nurse enters

commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display

(26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4,

lines 54-56). The information concerning the patient medication requirement is stored in the

pharmacy system (14, Fig. 1) and when the medication package given to the patient include a

label with information such as patient's name, room number, doctor's name and other data as

required (see: column 4, lines 60 to column 5, lines 2). Kraft et al. further teaches a vision

subsystem (44, Fig. 4) that interacts with the medication unit from a selected container to the

medication package subsystem (38, Fig. 3) (see: column 6, lines 35-37). In addition, the vision

subsystem (44, Fig. 4) comprises two optic systems for comparing specific medication in order

to verify that the correct medication is being dispensed (see: column 7, lines 26-34). The

Examiner considers the comparison for dispensing purposes to include checking data

representative of a medical history of the patient corresponding to inputted patient data.

As per claim 27, Kraft et al. teaches a plurality of medication dispenser (12, Fig. 1)

coupled to a pharmacy computer system (14, Fig. 1) and to each other through a network (16,

Fig. 1) (Internet) (see: column 52-55). In addition, the vision subsystem (44, Fig. 4) compares

specific medication in order to verify that the correct medication is being dispensed (see: column

7, lines 26-34). The Examiner considers the comparison for dispensing purposes to include

checking data representative of a medical history of the patient corresponding to inputted patient

data.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,502,944 to Kraft et al. in view U.S. Patent No. 5,797,515 to Liff et al.

As per claim 2, Kraft et al. teaches a medication dispensing system that storing

information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1)

(see: column 4, lines 56-59). Kraft et al. further teaches a pharmacy computer system (14, Fig. 1)

which maintains a database of the medication, the manufacturer, the brand name, the generic

name, the dosage form, the location of the drug in the pharmacy, and pricing information (see:

column 1, lines 29-34). In addition, Kraft et al. teach a dispensing process where the nurse enters

commands through the system controller (34, Fig. 3) to retrieve medication for one or more

patients (see: column 4, lines 54-56).

Kraft et al. fails to teach data representative of a benefit plan associated with the patient,

and payment rules concerning payment for medical items associated with the benefit plan and

further comprising the step of charging for the dispensed medical item in accordance with the

payment rules.

Liff et al. teaches a drug dispensing system that uses an electronic third-party payor card for drug purchases at the doctor's office (see: column 4, lines 67 to column 5, lines 2). Liff et al. also teaches that during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: column 13, lines 12-42 and column 16, lines 40-52). The Examiner considers the step of verifying insurance and payment information a form of evaluating the rules and regulation associated with making a payment for a prescription.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the drug dispensing system as taught by Liff et al. within the medication dispensing system as taught by Kraft et al. with the motivation of having a patient's insurance information readily available at the physician's office, thereby avoiding the inconvenience of taking a trip the pharmacy (see: Liff et al.: column 4, lines 62-64).

As per claim 9, Kraft et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches a pharmacy computer system (14, Fig. 1) which maintains a database of the medication, the manufacturer, the brand name, the generic name, the dosage form, the location of the drug in the pharmacy, and pricing information (see: column 1, lines 29-34). In addition, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: column 4, lines 54-56).

Kraft et al. fails to teach storing and inputting data representative of a benefit plan associated with the patient. Kraft et al. also fails to teach charging for the medical item in

accordance with the payment rules associated with the benefit plan determined to be associated with the patient.

Liff et al. teaches a host computer (46, Fig. 1) using pharmacy software packages that provide standard administrative and accounting capabilities and support features of the dispensing system such as a document printer (60, Fig. 1), that generates documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1) that inputs the commands of the user (see: column 5, lines 19-25, 58-63 and column 7, lines 24-37). Liff et al. also teaches during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: column 13, lines 12-42, column 16, lines 40-52 and Fig. 1).

The motivation for combining the teaching of Kraft et al. and Liff et al. are discussed in the rejection of claim 2, and are incorporated herein.

5.   Claims 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,502,944 to Kraft et al. in view U.S. Patent No. 5,797,515 to Liff et al. in further view of Official Notice.

As per claim 3, Kraft et al. and Liff et al. teaches a card reader (38, Fig. 1) mounted directly to or near the cabinet and connected to the host computer (46, Fig. 1), where the patient inserts a card (39, Fig. 1) in the card reader (38, Fig. 1) to automatically receive medicine from the cabinet (see: Liff et al.: column 5 lines 47-53 and Fig. 1).

Kraft et al. and Liff et al. fail to teach a reading a credit or debit card with a card reading device adjacent the dispenser, wherein the card reading device is in operative connection with

the computer, and the charging step includes charging an account associated with the credit or debit card.

The Examiner takes Official Notice that, in the medical industry, the use of cash, checks or credit cards are old and well-known methods of payment for patient health care. One of ordinary skill in the art would have found it obvious at the time the invention was made to include the charging of a customer's credit or debit card with the system as taught by the Kraft et al. and Liff et al. with the motivation of providing a fast and beneficial way for customers to make purchase and payment for prescription medicine.

As per claims 4-6, Kraft et al. and Liff et al. et al. teaches a drug dispensing system that uses an electronic third-party payor card for drug purchases at the doctor's office (see: Liff et al. column 4, lines 67 to column 5, lines 2). Kraft et al. and Liff et al. also teaches that during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines 12-42 and column 16, lines 40-52).

Kraft et al. and Liff et al. fail to explicitly teach a charging step of charging the benefits provider, charging the co-pay amount and charging the benefits provider the benefit amount.

The Examiner takes Official Notice that, in the medical industry cash, checks or credit cards are old and well-known methods of payment for patient health care, for instance, a patient may have to pay a deductible to be seen by a their physician usually about $10-15 dollars with a credit card and the patient's medical insurance company would pay for the remaining amount.

The motivation for combining the teaching of Kraft et al. and Liff et al. are discussed in the rejection of claim 3, and are incorporated herein.

As per claims 7 and 8, Kraft et al. and Liff et al. fail to explicitly teach inputting and outputting information representative of the co-payment amount and acceptance of the co-pay amount.

However, Kraft et al. and Liff et al. teach a host computer (46, Fig. 1) using pharmacy software packages that provide standard administrative and accounting capabilities and support features of the dispensing system such as a document printer (60, Fig. 1), that generates documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1) that inputs the commands of the user (see: Liff et al. column 5, lines 19-25, 58-63 and column 7, lines 24-37). Kraft et al. and Liff et al. also teach during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines 12-42, column 16, lines 40-52 and Fig. 1).

The motivation for combining the teaching of Kraft et al. and Liff et al. are discussed in the rejection of claim 3, and are incorporated herein.

6.   Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,502,944 to Kraft et al. in view Official Notice.

As per claim 24, Kraft et al. teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2) to retrieve medication for one or more patients (see: column 4, lines 54-56).

Kraft et al. fails to teach contacting the patient corresponding to the data inputted in step (c) after failing to executing step (d).

The Examiner takes Official Notice that it is common in the medical field, for a patient or a physician to be contacted if the pharmacist in order to clarify any discrepancies or make any modification to the prescription does not verify prescription information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of contacting a patient to verify information within the system as taught by Kraft et al. with the motivation of gathering accurate and reliable patient information thereby ensuring that the patient receives the correct prescription.

As per claim 25, Kraft et al. teaches a medication dispensing system that storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches a dispensing process where the nurse enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4, lines 54-56). The information concerning the patient medication requirement is stored in the pharmacy system (14, Fig. 1) and when the medication package given to the patient include a label with information such as patient's name, room number, doctor's name and other data as required (see: column 4, lines 60 to column 5, lines 2).

Kraft et al. fails to explicitly teach contacting the physician responsive to the failing of step (d).

The Examiner takes Official Notice that it is common in the medical field, for a patient or a physician to be contacted if the pharmacist in order to clarify any discrepancies or make any modification to the prescription does not verify prescription information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

include a method of contacting a patient to verify information within the system as taught by

Kraft et al. with the motivation of gathering accurate and reliable patient information thereby

ensuring that the patient receives the correct prescription.

7.   Claims 28-31, 34-39 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 5,502,944 to Kraft et al. in view U.S. Patent No. 5,036,462 to Kaufman et

al.

As per claim 28, Kraft teaches a dispensing process where the nurse enters commands

through the system controller (34, Fig. 3) to retrieve medication for one or more patients (see:

column 4, lines 54-56).

Kraft et al. fails to teach a dispenser comprises a patient accessible self-service medical

item dispenser.

Kaufman et al. teaches an interactive patient assistance and delivery system that includes

a system (200, Fig. 11) for storing and delivering of individual pills or caplets as well as both

external and internal devices (55, Fig. 5) for receiving input from the physician (or healthcare

professional at the central monitoring facility 28, Fig. 4a), the individual patient, the physical

testing devices (34, Fig. 4a) and (36, Fig. 4a) and the environmental sensors (23, Fig. 8a) and

(25, Fig. 8a) in order to gain access to the medication delivery system (20, Fig. 5) (see: column

8, lines 15-23, column 17, lines 1-22 and Fig. 11-13).

One of ordinary skill in the art at the time the invention was made would have found it

obvious to include receiving patient input to gain access the medication delivery system as taught

by Kaufman et al. within the medication dispensing system as taught by Kraft et al. with the

motivation of providing a system with a reasonable degree of self-sufficiency and personal

control over the administration of medication without sacrificing the overall therapeutic

objectives of the prescribed medical treatment (see: Kaufman et al.: column 2, lines 4-7).

As per claim 29, Kaufman et al. teaches prior to (d), receiving input from a patient

through at least one input device in operative connection with the computer and the dispenser.

This limitation is met by the system (20, Fig. 5) including various external input devices that

receive commands from the patient, which are communicated to the control element (50, Fig. 5)

through the main CPU (22, Fig. 4) for the administering of medication "upon demand" (see:

column 8, lines 30-37).

As per claim 30, Kaufman et al. teaches (f) includes receiving dispense request input

from the patient corresponding to at least one medical item prescribed for use by the patient. This

feature is met by the system (20, Fig. 5) including various external input devices that receive

commands from the patient, which are communicated to the control element (50, Fig. 5) through

the main CPU (22, Fig. 4) for the administering of medication "upon demand" (see: column 8,

lines 30-37). In addition, the medication control element (50, Fig. 5) can store and selectively

administer medication upon demand by patient (see: column 9, lines 17-25).

As per claim 31, Kraft et al. teaches receiving a payment from the patient corresponding

to the at least one medical item requested in the dispense request input. This limitation is met by

the plurality of dispensers that are networked together and connected to a common database of

patient information, typically a pharmacy software system. Medications are automatically

dispensed responsive to a user request in accordance with the information in the database and the

dispensers communicates data for accounting and billing purposes, to the pharmacy system or to

another system (see: column 2, lines 22-29).

As per claim 34, Kraft et al. teaches storing information concerning a patient's

medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft

et al. further teaches that during the dispensing process a nurse using a keyboard (28, Fig. 2)

enters commands through the system controller (34, Fig. 3) for orders of all or part of the

authorized medication for each of the nurse's patients for a given medication round and the

medication dispenser (12, Fig. 1) retrieves each medication from its respective container and

dispenses the medication (see: column 4, lines 54-65). In addition, Kraft et al. teaches that the

system controller (34, Fig. 3) communicates accounting information for bill purposes as the

medication is dispensed and the information concerning the quantity and type of medication

dispensed for each is patient is communicated to the pharmacy system (see: column 5, lines 47-

55). Moreover, Kraft et al teaches a vision subsystem (44, Fig. 4) comprises two optic systems

for comparing specific medication in order to verify that the correct medication is being

dispensed (see: column 7, lines 26-34).

Kraft et al. fails to teach:

(a) at least one medical item stored in a patient-accessible self service medical item

dispenser apparatus, wherein the dispenser apparatus is operative to receive at least one input

from the at least one patient;

(c) responsive to the request to dispense, instructing the dispenser apparatus to dispense

the requested at least one medical item to the first patient;

Kaufman et al. teaches an interactive patient assistance and delivery system that includes

a system (200, Fig. 11) for storing and delivering of individual pills or caplets as well as both

external and internal devices (55, Fig. 5) for receiving input from the physician (or healthcare

professional at the central monitoring facility 28, Fig. 4a), the individual patient, the physical

testing devices (34, Fig. 4a) and (36, Fig. 4a) and the environmental sensors (23, Fig. 8a) and

(25, Fig. 8a) in order to gain access to the medication delivery system (20, Fig. 5) (see: column

8, lines 15-23, column 17, lines 1-22 and Fig. 11-13).

The obviousness of combining the teachings of Kaufman et al. within the system as

taught by Kraft et al. is discussed in the rejection of claim 28, and incorporated herein.

As per claim 35, Kraft et al. teaches the claimed responsive to the verification, including

in the data store, data linking each of the first patient, the dispensed at least one medical item,

and location of dispensing the at least one medical item. This limitation is met during the

dispensing process when a nurse using a keyboard (28, Fig. 2) enters commands through the

system controller (34, Fig. 3) for orders of all or part of the authorized medication for each of the

nurse's patients for a given medication round and the medication dispenser (12, Fig. 1) retrieves

each medication from its respective container and dispenses the medication (see: column 4, lines

54-65). In addition, Kraft et al. teaches that the system controller (34, Fig. 3) communicates

accounting information for bill purposes as the medication is dispensed and the information

concerning the quantity and type of medication dispensed for each is patient is communicated to

the pharmacy system (see: column 5, lines 47-55). Moreover, Kraft et al teaches a vision

subsystem (44, Fig. 4) comprises two optic systems for comparing specific medication in order

to verify that the correct medication is being dispensed (see: column 7, lines 26-34). The

Examiner considers the nurse to be entering information regarding multiple patient and the

dispensed medication could be for one or more patient.

As per claim 36, Kraft et al. teaches (f) receiving another at least one input through the at least one input device of the dispenser apparatus, wherein the another at least one input includes a request to dispense to a second patient at least one medical item prescribed for use by the second patient; and

(g) responsive to the request to dispense to the second patient, instructing the dispenser apparatus to dispense the requested at least one medical item to the second patient. These limitations are met during the dispensing process a nurse using a keyboard (28, Fig. 2) enter commands through the system controller (34, Fig. 3) to retrieve medication for one or more patients (reads on "request to dispense to a second patient") (see: column 4, lines 54-56).

Kraft et al. fails to teach dispensing to the patient.

Kaufman et al. teaches an interactive patient assistance and delivery system that includes a system (200, Fig. 11) for storing and delivering of individual pills or caplets as well as both external and internal devices (55, Fig. 5) for receiving input from the physician (or healthcare professional at the central monitoring facility 28, Fig. 4a), the individual patient, the physical testing devices (34, Fig. 4a) and (36, Fig. 4a) and the environmental sensors (23, Fig. 8a) and (25, Fig. 8a) in order to gain access to the medication delivery system (20, Fig. 5) (see: column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-13).

The obviousness of combining the teachings of Kaufman et al. within the system as taught by Kraft et al. is discussed in the rejection of claim 28, and incorporated herein.

As per claim 37, Kraft et al. teaches storing information concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches that during the dispensing process a nurse using a keyboard (28, Fig. 2)

enters commands through the system controller (34, Fig. 3) for orders of all or part of the authorized medication for each of the nurse's patients for a given medication round and the medication dispenser (12, Fig. 1) retrieves each medication from its respective container and dispenses the medication (see: column 4, lines 54-65). In addition, Kraft et al. teaches that the system controller (34, Fig. 3) communicates accounting information for bill purposes as the medication is dispensed and the information concerning the quantity and type of medication dispensed for each is patient is communicated to the pharmacy system (see: column 5, lines 47-55).

Kraft et al. fails to teach:

wherein (b) includes receiving dispense request input from the first patient through an input device in operative connection with the first dispenser, and further comprising

receiving dispense request input from the second patient through an input device in operative connection with the second dispenser;

responsive to (f), instructing the second dispenser to dispense to the second patient at least one medical item prescribed for use by the second patient.

Kaufman et al. teaches an interactive patient assistance and delivery system that includes a system (200, Fig. 11) for storing and delivering of individual pills or caplets as well as both external and internal devices (55, Fig. 5) for receiving input from the physician (or healthcare professional at the central monitoring facility 28, Fig. 4a), the individual patient, the physical testing devices (34, Fig. 4a) and (36, Fig. 4a) and the environmental sensors (23, Fig. 8a) and (25, Fig. 8a) in order to gain access to the medication delivery system (20, Fig. 5) (see: column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-13).

The obviousness of combining the teachings of Kaufman et al. within the system as

taught by Kraft et al. is discussed in the rejection of claim 28, and incorporated herein.

As per claim 38, Kraft et al teaches (f) prior to (c), receiving with the dispenser apparatus

a patient payment input. This limitation is met during the dispensing process a nurse enters

commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video display

(26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see: column 4,

lines 54-56). In addition, Kraft et al. teaches that a system controller (34, Fig. 3) communicates

accounting information for the bill purposes of the patient as the medication is dispensed and the

information concerning the quantity and type of medication dispensed for each is patient is

communicated to the pharmacy system (see: column 5, lines 47-55). The Examiner considers the

video display connected to the dispenser capable of including the accounting information such as

patient payment information before the information is communicated to the pharmacy system.

As per claim 39, it is rejected for the same reasons set forth in claim 31.

As per claim 42, Kraft et al. teaches (g) prior to (c), displaying a payment amount to the

patient with the display screen. This feature is met during the dispensing process when a nurse

enters commands through the system controller (34, Fig. 3) using a keyboard (28, Fig. 2), video

display (26, Fig. 2) and printer (30, Fig. 2) all connected to the medication dispenser (see:

column 4, lines 54-56). In addition, Kraft et al. teaches that a system controller (34, Fig. 3)

communicates accounting information for the bill purposes of the patient as the medication is

dispensed and the information concerning the quantity and type of medication dispensed for each

is patient is communicated to the pharmacy system (see: column 5, lines 47-55). The Examiner

considers the video display connected to the dispenser capable of including the accounting

information such as patient payment information before the information is communicated to the

pharmacy system.

As per claim 43, Kraft teaches the claimed prior to (c), determining whether the at least

one medical item corresponding to the dispense request input is available for dispensing from the

dispenser apparatus. This limitation is met by the control electronics (36, Fig. 3) that maintains a

database of information concerning the contents of the dispenser. In response to a request, the

control electronics (36, Fig. 3) determines whether all requested medications are available (see:

column 6, lines 19-22).

As per claim 44, Kraft et al. teaches the claimed (d) further comprises at least one sensor

in the dispenser apparatus transmitting at least one signal responsive to the at least one sensor

sensing a passing of the requested at least one medical item, and (e) further comprises including

in the data store verification of the dispensing of the at least one medical item. This limitation is

met by the detector (340, Fig. 24) that outputs a signal indicating whether a pill from a container

(130, Fig. 8) has landed in the package (see: column 12, lines 58-66).

9.   Claims 32-33, 40-41 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable

over U.S. Patent No. 5,502,944 to Kraft et al. and U.S. Patent No. 5,036,462 to Kaufman et al. in

view of U.S. Patent No. 5,301,105 to Cummings, Jr.

As per claim 32, Kraft et al. and Kaufman et al. teach system (20, Fig. 5) including

various external input devices that receive commands from the patient, which are communicated

to the control element (50, Fig. 5) through the main CPU (22, Fig. 4) for the administering of

medication "upon demand" (see: Kaufman et al.: column 8, lines 30-37). In addition, the

medication control element (50, Fig. 5) can store and selectively administer medication upon

demand by patient (see: Kaufman et al.: column 9, lines 17-25). Furthermore, Kraft et al. and

Kaufman et al. teach that a plurality of dispensers are networked together and connected to a

common database of patient information, typically a pharmacy software system. Medications are

automatically dispensed responsive to a user request in accordance with the information in the

database and the dispensers communicates data for accounting and billing purposes (reads on

"charging an account"), to the pharmacy system or to another system (see: Kraft et al.: column 2,

lines 22-29).

Kraft et al. and Kaufman et al. fail to teach at least one input device includes a card

reader device, wherein the card reader device is in operative connection with the computer, and

further comprising:

(g) reading a credit or debit card with the card reader device, and charging an account

associated with the credit or debit card.

Cummings, Jr. teaches a fully integrated and comprehensive health care system with a

terminal that includes a main housing (50, Fig. 2) having a visual display window (51, Fig. 2)

and a card data entry slot (52, Fig. 2) used for inserting a conventional or special data-containing

card (e.g., a swipe card) into the entry slot and moving it laterally (see: column 7, lines 17-37).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to include the fully integrated and comprehensive health care system

with card entry slot (52, Fig. 2) as taught by Cummings, Jr. with the system of Kraft et al. and

Kaufman et al. with motivation of providing a reliable and simple method of payment for a

patient health care.

As per claim 33, Kraft et al. and Kaufman et al. teach system (20, Fig. 5) including

various external input devices that receive commands from the patient, which are communicated

to the control element (50, Fig. 5) through the main CPU (22, Fig. 4) for the administering of

medication "upon demand" (see: Kaufman et al.: column 8, lines 30-37). In addition, the

medication control element (50, Fig. 5) can store and selectively administer medication upon

demand by patient (see: Kaufman et al.: column 9, lines 17-25). Furthermore, Kraft et al. and

Kaufman et al. teach that a plurality of dispensers are networked together and connected to a

common database of patient information, typically a pharmacy software system. Medications are

automatically dispensed responsive to a user request in accordance with the information in the

database and the dispensers communicates data for accounting and billing purposes (reads on

"payment"), to the pharmacy system or to another system (see: Kraft et al.: column 2, lines 22-

29).

Kraft et al. and Kaufman et al. fail to teach the payment comprises a co-payment, wherein

(f) includes receiving the co-payment from the patient corresponding to the at least one medical

item requested in the dispense request input.

Cummings, Jr. teaches a fully integrated and comprehensive health care system with a

terminal that includes a main housing (50, Fig. 2) having a visual display window (51, Fig. 2)

and a card data entry slot (52, Fig. 2) used for inserting a conventional or special data-containing

card (e.g., a swipe card) into the entry slot and moving it laterally (see: column 7, lines 17-37).

Cummings, Jr. further teaches after a card is swiped (101, Fig. 5) and the charges to the patient

are in agreement the System processor calculates any patient co-pay and/or deductible (140, Fig.

6) and payment is transmitted to provider account (204, Fig. 8) (see: column 12, lines 22-32 and

column 13, lines 41-58).

The obviousness of combining the teachings of Cummings, Jr. with the system of Kraft et

al. and Kaufman et al. is discussed in the rejection of claim 32, and incorporated herein.

As per claims 40-41, they are rejected for the same reasons set forth in claims 33 and 32,

respectively.

As per claim 45, Kraft teaches a method comprising

(a) storing in at least one data store in operative connection with at least one computer,

data representative of each of:

a plurality of types of medical items,

the type of medical item stored in each respective storage location,

at least one patient, and

at least one medical item type prescribed for use by the at least one patient is met by

storing information concerning a patient's medication requirements on the pharmacy system (14,

Fig. 1) that maintains a database of the medication, the manufacturer, the brand name, the

generic name, the dosage form, the location of the drug in the pharmacy, and pricing information

(see: column 1, lines 29-34 and column 4, lines 56-59);

(g) dispensing from the dispenser apparatus to the patient the requested at least one

medical item type, wherein the at least one medical item type is dispensed from at least one

storage location holding the at least one medical item type is met by the dispensing process

where the nurse enter commands through the system controller (34, Fig. 3) to retrieve medication

for one or more patients (see: column 4, lines 54-56);

(h) verifying with the dispenser apparatus that the requested at least one medical item

type was dispensed to the patient, including at least one sensor in the dispenser apparatus

transmitting at least one signal to the computer responsive to the at least one sensor sensing a

passing of the requested at least one medical item type is met by the vision subsystem (44, Fig.

4) comprises two optic systems for comparing specific medication in order to verify that the

correct medication is being dispensed (see: column 7, lines 26-34); and

(i) including in the at least one data store responsive to (h), data linking each of the

patient, the verified dispensed at least one medical item type, and location of the dispensing of

the verified dispensed at least one medical item type is met by the vision subsystem (44, Fig. 4)

comprises two optic systems for comparing specific medication in order to verify that the correct

medication is being dispensed (see: column 7, lines 26-34).

Furthermore, Kraft et al. teach that a plurality of dispensers are networked together and

connected to a common database of patient information, typically a pharmacy software system.

Medications are automatically dispensed responsive to a user request in accordance with the

information in the database and the dispensers communicates data for accounting and billing

purposes (reads on "(e) charging an amount to an account, wherein the amount corresponds to a

payment associated with the requested at least one medical item type"), to the pharmacy system

or to another system (see: column 2, lines 22-29).

Kraft et al. fails to teach:

dispensing to the patient;

a plurality of medical item in a patient-accessible self service medical item dispenser

apparatus;

(b) receiving patient identification data from a patient through at least one input device of the dispenser apparatus;

(c) receiving from the patient through the at least one input device a request to dispense at least one medical item type prescribed for use by the patient; and

(f) instructing the dispenser apparatus to dispense to the patient the requested at least one medical item type.

Kaufman et al. teaches an interactive patient assistance and delivery system that includes a system (200, Fig. 11) for storing and delivering of individual pills or caplets as well as both external and internal devices (55, Fig. 5) for receiving input from the physician (or healthcare professional at the central monitoring facility 28, Fig. 4a), the individual patient, the physical testing devices (34, Fig. 4a) and (36, Fig. 4a) and the environmental sensors (23, Fig. 8a) and (25, Fig. 8a) in order to gain access to the medication delivery system (20, Fig. 5) (see: column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-13). In addition, Kaufman teaches a medication control element (50, Fig. 5) that can store and selectively administer medication upon demand by patient (see: column 9, lines 17-25).

The obviousness of combining the teachings of Kaufman et al. within the system as taught by Kraft et al. is discussed in the rejection of claim 28, and incorporated herein.

Kraft et al. and Kaufman fail to teach:

(d) reading a credit or debit card with a card reader device of the dispenser apparatus.

Cummings, Jr. teaches a fully integrated and comprehensive health care system with a terminal that includes a main housing (50, Fig. 2) having a visual display window (51, Fig. 2)

and a card data entry slot (52, Fig. 2) used for inserting a conventional or special data-containing

card (e.g., a swipe card) into the entry slot and moving it laterally (see: column 7, lines 17-37).

The obviousness of combining the teachings of Cummings, Jr. with the system of Kraft et

al. and Kaufman et al. is discussed in the rejection of claim 32, and incorporated herein.

(11)   Response to Argument

In the Appeal Brief filed 15 April 2004, Appellant makes the following arguments:

(A) Kraft does not teach both recording that a type of medical item has been dispensed

for use by the patient and recording that the type of medical item has been dispensed from the

dispenser (claim 1).

(B) Appellant argues that Kraft reference fail to teach limitation of claims 10-23 and 26-

27.

(C) There is no teaching, suggestion, or motivation cited so as to produce Appellant's

invention and without a motivation to combine, a rejection based on *prima facie* of obviousness

is improper.

(D) Liff reference cannot constitute prior art pursuant to 35 USC § 103(a) because Liff

has a filing date of May 3, 1996 and claims priority as a continuation-in-part of U.S. Patent

5,713,485 filed October 18, 1995 and the present invention is entitled to earlier priority,

including at least the December 16, 1994 filing date of U.S. Patent No. 5,790,409.

(E) Since the Liff reference does not constitute prior art to the subject matter of claim 1,

and claims 2-9 include subject matter of claim 1, it also does not constitute prior art to the

subject matter of claims 2-9.

(F) The reliance on the Kraft and Liff references for the feature of claims 7-8 is improper.

(G) The Kraft and Liff references taken alone or in combination do not teach or suggest a benefit plan associated with a patient, and charging for a medical item in accordance with payment rules associated with the benefit plan.

(H) Appellant previously challenged (in Appeal Brief filed September 30, 2003) "Official Notice" assertion on the basis that it was not supported by any reference to prior art for claims 3-8 and 24-25.

(I) Appellant argues neither Kraft nor Liff reference taken alone or in combination teaches the limitation of claims 4-8 and 24-25.

(J) The modification of Kraft discloses a nurse using the dispenser not the patient, and combining the teachings of Kaufman regarding a patient-accessible self-service medical item dispenser would destroy the explicitly disclosed utility of the Kraft teaching.

(K) Kraft and Kaufman do not teach or suggest a secure patient-accessible self-service medical item dispenser in a hospital setting and teaches away from Kraft's required secure hospital environment.

(L) Appellant argues neither Kraft nor Kaufman reference taken alone or in combination teaches limitation of claims 29-31.

(M) Kraft does not teach or suggest verifying that requested medical item was dispensed, not including in a data store data linking the verified dispensed medical item to a patient (claim 34).

(N) Appellant argues neither Kraft nor Kaufman reference taken alone or in combination teaches limitation of claims 35-39 and 42-44.

(O) Cummings does not teach reading a credit or debit card with a card reader device associated with a medical item dispenser or charging an account associated with a credit or debit card (claim 32).

(P) Appellant argues that the Kraft, Kaufman and/or Cummings, Jr. reference taken alone or in combination teach limitation of claims 33, 40 and 41.

(Q) Cummings, Jr. is non-analogous art and a *prima facie* case of obviousness has not been established (claim 45).

Examiner will address Appellant's arguments in sequence as they appear in the brief.

Response to Arguments (A)

In response to this argument, the Examiner respectfully submits Kraft teaches that once the nurse orders all or part of the authorized medication for each of the nurse's patients for a given medication round, the medication dispenser (12, Fig. 1) retrieves each medication from its respective container and dispenses the medication (see: column 4, lines 60-65). In addition, Kraft teaches that the system controller (34, Fig. 1) communicates accounting information for accurately billing the patient. As the medications are dispensed, the information on the quantity and type of medication dispensed for each patient is communicated to the pharmacy system. Also, the information regarding the time of dispensing and the type and quantity of medication dispensed can be used to ensure that the medication was properly administered (see: column 5, lines 47-55). This clearly shows that as the medication is dispensed, information regarding quantity and type of medication dispensed for each patient is communicated or recorded to the pharmacy.

Response to Arguments (B)

Appellant's allegation that the applied reference fails to teach the claimed limitation of

claims 10-23 and 26-27 is respectfully submitted to be without merit. In particular, the Examiner

respectfully submits that Kraft et al. reference teaches the disputed feature. Note, for example,

column 4, lines 3-15 and Fig. 2 (claim 10), column 4, lines 54-56 (claim 11), column 4, lines 60

to column 5, lines 2 (claim 12), column 4, lines 54 to column 5, lines 2 (claims 13-14), column 4,

line 66 to column 5, line 7 (claim 15), column 4, lines 56 to column 5, lines 2 (claim 16), column

4, line 66 to column 5, line 7 (claims 17-19), column 4, lines 60 to column 5, lines 2 (claim 21-

22), column 12, lines 22-45 (claim 23), column 4, lines 60 to column 5, lines 2, column 6, lines

35-37 and column 7, lines 26-34 (claim 26) and column 7, lines 26-34 (claim 27) of the Kraft et

al. reference. Appellant's allegations that the Kraft et al. reference fails to teach the aformention

feature are merely conclusory, are not supported by any evidence provided by Appellant which

clearly and definitely call into question the cited passages of the applied reference. Appellant

has apparently failed to provide any reasonable analysis of the applied reference. Thus, it is

respectfully submitted that Appellant's conclusions cannot take the place of evidence. *In re Cole*,

51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d

600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

<u>Response to Arguments (C)</u>

In response to this argument, the Examiner respectfully submits that establishing a *prima*

facie case of obviousness is determined on the basis of the evidence as a whole and the relative

persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443,

1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992);

In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*,

531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner

respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of

obviousness, since he has presented evidence of corresponding claim elements in the prior art

and has expressly articulated the combinations and the motivations for combinations that fairly

suggest Appellant's claimed invention (see above).

In addition, the Examiner recognizes obviousness is not determined by what the

references expressly state but by what they would reasonably suggest to one of ordinary skill in

the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell,

Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598

(Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

> (i) obviousness does not require absolute predictability;
> (ii) non-preferred embodiments of prior art must also be considered; and
> (iii) <u>the question is not express teaching of references, but what they would suggest</u>.

Additionally, the Examiner recognizes that references cannot be arbitrarily altered or

modified and that there must be some reason why one skilled in the art would be motivated to

make the proposed modifications. However, although the Examiner agrees that the motivation

or suggestion to make modifications must be articulated, it is respectfully contended that there is

no requirement that the motivation to make modifications must be expressly articulated <u>within

the references themselves</u>. References are evaluated by what they suggest to one versed in the

art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

Furthermore, the motivation to combine the teachings of Liff et al. within the Kraft et al.

is given in section 4 above suggested in a passage from the Liff et al. column 4, lines 62-64,

"having a patient's insurance information readily available at the physician's office, thereby

avoiding the inconvenience of taking a trip the pharmacy".

As such, it is respectfully submitted that an explanation based on logic and sound

scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a

holding of obviousness has been adequately provided by the motivations and reasons indicated

by the Examiner in the prior Office Action (paper number 5), *Ex parte Levengood*, 28 USPQ2d

1300 (Bd. Pat. App. & Inter., 4/22/93).

Response to Arguments (D) and (E)

In response to these arguments, the Examiner respectfully submits that the Liff reference

was only relied on for the teachings of "data representative of a benefit plan associated with the

patient, and payment rules concerning payment for medical items associated with the benefit

plan and the step of charging for the dispensed medical item in accordance with the payment

rules" in claims 2-9. In addition, Liff has a filing date of May 3, 1996 and claims priority as a

continuation-in-part of U.S. Patent 5,713,485 filed October 18, 1995 and the present invention is

entitled to an earlier priority, including at least the December 16, 1994 filing date of U.S. Patent

No. 5,790,409 (hereinafter "Fedor"). The reference of Fedor does not cite or mention a benefit

plan or payment rules associated with a benefit plan and the Liff reference is used to reject this

particular limitation only, therefore the use of the Liff reference is proper and maintained.

Response to Arguments (F)

In response to this argument, the Examiner respectfully submits that discussed above in

arguments (D) and (E), Liff is relied on teaching a "benefit plan associated with the patient, and

payment rules concerning payment for medical items" as recited in claim 3. In addition, the

limitation in claims 7-8 recite payment rules such as indicia representative of a co-payment and

the reference of Kraft et al. and Liff et al. teach a host computer (46, Fig. 1) using pharmacy

software packages that provide standard administrative and accounting capabilities and support

features of the dispensing system such as a document printer (60, Fig. 1), that generates

documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1)

that inputs the commands of the user (see: Liff et al. column 5, lines 19-25, 58-63 and column 7,

lines 24-37). Kraft et al. and Liff et al. also teach during the claim adjudication step (286, Fig.

12) a patient's insurance information is automatically verified to determine whether the insurer

will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines

12-42, column 16, lines 40-52 and Fig. 1). Therefore, the Examiner admission that Liff reference

is only relied on for benefit plans and payment rules are proper and maintained.

Response to Arguments (G)

In response to this argument, the Examiner respectfully submits that Liff et al. teaches a

drug dispensing system that uses an electronic third-party payor card for drug purchases at the

doctor's office (see: column 4, lines 67 to column 5, lines 2). Liff et al. also teaches that during

the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically

verified to determine whether the insurer will pay for the prescription and if any co-payment is

required (see: column 13, lines 12-42 and column 16, lines 40-52). This clearly indicates that

insurance information is verified to determine patient's benefit plan information in order to

determine the co-payment information and insurer payment information for a particular

prescription.

Response to Arguments (H)

In response to this argument, the Examiner firstly notes that Appellant's present challenge

to the basis of rejection made in an Office Action dated June 4, 2003, is not timely. In particular,

the courts have held that "If appellant does not seasonably traverse the well known statement

during examination, then the object of the well known statement is taken to be admitted prior

art". *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge

constitutes a demand for evidence made as soon as practicable during prosecution. Thus,

appellant is charged with rebutting the well known statement in the next reply after the Office

action in which the well known statement was made.

In light of the above, it is evident that Appellant's present challenge should have been

made in the next reply to the Office Action dated December 18, 2002, namely the Amendment

and response filed September 25, 2002. Because of Appellant's failure to seasonably traverse the

"well known statements" made on the Office Action dated December 18, 2002, Appellant's

present rebuttal is moot, since the object of the well known statement is taken to be admitted

prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Secondly, the Examiner respectfully directs Appellant's attention to U.S. Patent No.

5,070,452 to Doyle, Jr. et al. (cited herewith) regarding claims 3-8, which clearly evidences that

charging an patient's account associated with a credit or debit card as far back as December 3,

1987, which is prior to the filing of Appellant's present application (note especially col. 6, lines

3-30). As such, the knowledge of a charging step including charging an account associated with

a credit or debit card, in general, has clearly existed in the art prior to Appellant's claimed

invention and the courts have held that even if a patent does not specifically disclose a particular

element, said element being within the knowledge of a skilled artisan, the patent taken in

combination with that knowledge, would put the artisan in possession of the claimed invention.
In re Graves, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Furthermore, regarding claims 24-25 Appellant's is directed to U.S. Patent No. 5,950,630
to Portwood et al. (cited herewith), which clearly evidences that physician and patient are
notified of any abnormalities found regarding verification of pharmaceutical data as far back as
December 12, 1996, which is prior to the filing of Appellant's present application (note
especially abstract). As such, the knowledge of contacting physicians and patients regarding
discrepancies in verification of prescription information, in general, has clearly existed in the art
prior to Appellant's claimed invention and the courts have held that even if a patent does not
specifically disclose a particular element, said element being within the knowledge of a skilled
artisan, the patent taken in combination with that knowledge, would put the artisan in possession
of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

<u>Response to Arguments (I)</u>

Appellant's allegation that the applied reference fails to teach the claimed limitation of
claims 4-6 and 24-25 is respectfully submitted to be without merit. In particular, the Examiner
respectfully submits that Kraft et al. and Liff et al. reference teaches the disputed feature. Note,
for example, column 4, lines 67 to column 5, lines 2, column 13, lines 12-42 and column 16,
lines 40-52 (claims 4-6) and column 5, lines 19-25, 58-63 and column 7, lines 24-37 and column
13, lines 12-42, column 16, lines 40-52 and Fig. 1 (claims 7-8) of the Liff et al. reference and
column 4, 54-56 (claims 24-25) of Kraft et al. Appellant's allegations that the Kraft et al. and
Liff et al. reference fail to teach the aformention feature are merely conclusory, are not supported
by any evidence provided by Appellant which clearly and definitely call into question the cited

passages of the applied reference. Appellant has apparently failed to provide any reasonable

analysis of the applied reference. Thus, it is respectfully submitted that Appellant's conclusions

cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230

(1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v.*

Mindick, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Response to Arguments (J)

In response to this argument, the Examiner respectfully submits Kraft et al. teaches

storing information concerning a patient's medication requirements on the pharmacy system (14,

Fig. 1) (see: column 4, lines 56-59). Kraft et al. further teaches that during the dispensing process

a nurse using a keyboard (28, Fig. 2) enters commands through the system controller (34, Fig. 3)

for orders of all or part of the authorized medication for each of the nurse's patients for a given

medication round and the medication dispenser (12, Fig. 1) retrieves each medication from its

respective container and dispenses the medication (see: column 4, lines 54-65). In addition, Kraft

et al. teaches that the system controller (34, Fig. 3) communicates accounting information for bill

purposes as the medication is dispensed and the information concerning the quantity and type of

medication dispensed for each is patient is communicated to the pharmacy system (see: column

5, lines 47-55). Moreover, Kraft et al teaches a vision subsystem (44, Fig. 4) comprises two optic

systems for comparing specific medication in order to verify that the correct medication is being

dispensed (see: column 7, lines 26-34). Kaufman et al. teaches an interactive patient assistance

and delivery system that includes a system (200, Fig. 11) for storing and delivering of individual

pills or caplets as well as both external and internal devices (55, Fig. 5) for receiving input from

the physician (or healthcare professional at the central monitoring facility 28, Fig. 4a), the

individual patient, the physical testing devices (34, Fig. 4a) and (36, Fig. 4a) and the

environmental sensors (23, Fig. 8a) and (25, Fig. 8a) in order to gain access to the medication

delivery system (20, Fig. 5) (see: column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-13).

This clearly indicates that Kaufman reference states that an individual patient enters information

in order to gain access to the medication delivery system. As such, the proper combination of

Kraft et al. and Kaufman et al. is to extend Kraft's patient medication dispensing system and the

receiving input to gain access to the medication delivery system, as taught by Kaufman. As such,

the Examiner disputes that the incorporating Kaufman's medication delivery system would

destroy the explicitly disclosed utility of the Kraft teaching.

Response to Arguments (K)

In addition, with respect to Appellant's argument that Kaufman teaches away from the

invention, the Examiner respectfully disagrees. In particular, Appellant's remarks appear to be

based on the premise that Kaufman's teaches that medication can be dispensed upon demand by

the patient (see: column 9, lines 17-25). Appellant then concludes that Kaufman's teaches

against having a secure patient-accessible self-service medical item dispenser, especially in

hospital setting as, indicated in page 34 of the Appeal Brief (dated 4/12/04) teaches away from

the invention. This position is incorrect for the following reasons. The combination purported by

the Examiner does not discourage using authorization identification for dispensing medication

from a dispenser in a secure hospital environment, as the Examiner never relied upon Kaufman

for this limitation. Kaufman was relied on for teaching an interactive patient assistance and

delivery system that includes a system (200, Fig. 11) for storing and delivering of individual pills

or caplets as well as both external and internal devices (55, Fig. 5) for receiving input from the

physician (or healthcare professional at the central monitoring facility 28, Fig. 4a), the individual

patient, the physical testing devices (34, Fig. 4a) and (36, Fig. 4a) and the environmental sensors

(23, Fig. 8a) and (25, Fig. 8a) in order to gain access to the medication delivery system (20, Fig.

5) (see: column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-13). The only modification

proposed by the Examiner was that of incorporating of a dispensing process where the nurse

enters commands through the system controller (34, Fig. 3) to retrieve medication for one or

more patients disclosed by Kraft et al. (see: column 4, lines 54-56) in secure hospital setting (see:

column 1, lines 5-8). Moreover, it should be noted that the cited reference(s) was never applied

as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner disputes

that Kaufman remarks provide a teaching away from the manner in which Examiner applied the

reference in addressing claim limitation. Additionally, it is respectfully submitted that if

Appellant were correct in his assertion which Examiner does not admit, it has been held that

prior art reference must be considered in its entirety, i.e., as a whole, including portions that

would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.,* 721

F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Response to Arguments (L)

Appellant's allegation that the applied reference fails to teach the claimed limitation of

claims 29-31 is respectfully submitted to be without merit. In particular, the Examiner

respectfully submits that Kraft et al. and Kaufman et al. reference teaches the disputed feature.

Note, for example, column 8, lines 30-37 (claim 29) and column 9, lines 17-25 (claims 30) of

Kaufman et al. and column 2, lines 22-29 (claim 31) of Kraft et al. Appellant's allegations that

the Kraft et al. and Kaufman et al. reference fail to teach the aformention feature are merely

conclusory, are not supported by any evidence provided by Appellant which clearly and

definitely call into question the cited passages of the applied reference. Appellant has apparently

failed to provide any reasonable analysis of the applied reference. Thus, it is respectfully

submitted that Appellant's conclusions cannot take the place of evidence. *In re Cole*, 51 CCPA

919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145

USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Response to Arguments (M)

In response to this argument, the Examiner respectfully submits Kraft et al. teaches a

system controller (34, Fig. 3) that communicates accounting information for bill purposes as the

medication is dispensed and the information concerning the quantity and type of medication

dispensed for each is patient is communicated to the pharmacy system (see: column 5, lines 47-

55). Moreover, Kraft et al teaches a vision subsystem (44, Fig. 4) comprises two optic systems

for comparing specific medication in order to verify that the correct medication is being

dispensed (see: column 7, lines 26-34). This clearly demonstrates that through the use of the

system controller and vision subsystem, a verification step is completed to confirm the quantity

and type of medication dispensed for each patient.

Response to Arguments (N)

Appellant's allegation that the applied reference fails to teach the claimed limitation of

claims 35-39 and 42-44 is respectfully submitted to be without merit. In particular, the Examiner

respectfully submits that Kraft et al. reference teaches the disputed feature. Note, for example,

column 4, lines 54-65, column 5, lines 47-55 and column 7, lines 26-34 (claim 35) of Kraft,

column 4, lines 54-56 (claim 36) of Kraft, column 8, lines 15-23, column 17, lines 1-22 and Fig.

11-13 (claim 36) of Kaufman, column 4, lines 56-59 and column 5, lines 47-55 (claim 37) of

Kraft, column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-13 (claim 37) of Kaufman,

column 4, lines 54-56 and column 5, lines 47-55 (claim 38) of Kraft, column 2, lines 22-29

(claim 39) of Kraft, column 4, lines 54-56 and column 5, lines 47-55 (claim 42) of Kraft, column

6, lines 19-22 (claim 43) of Kraft and column 12, lines 58-66 (claim 44) of Kraft. Appellant's

allegations that the Kraft et al. and Kaufman et al. reference fail to teach the aformention feature

are merely conclusory, are not supported by any evidence provided by Appellant which clearly

and definitely call into question the cited passages of the applied reference. Appellant has

apparently failed to provide any reasonable analysis of the applied reference. Thus, it is

respectfully submitted that Appellant's conclusions cannot take the place of evidence. *In re Cole*,

51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d

600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

<u>Response to Arguments (O)</u>

In response to this argument, the Examiner respectfully submits that Kraft et al. and

Kaufman et al. are relied on for teaching a system (20, Fig. 5) including various external input

devices that receive commands from the patient, which are communicated to the control element

(50, Fig. 5) through the main CPU (22, Fig. 4) for the administering of medication "upon

demand" (see: Kaufman et al.: column 8, lines 30-37). Moreover, medications are automatically

dispensed responsive to a user request in accordance with the information in the database and the

dispensers communicates data for accounting and billing purposes, to the pharmacy system or to

another system (see: Kraft et al.: column 2, lines 22-29). Cummings, Jr. is relied on for teachings

a fully integrated and comprehensive health care system with a terminal that includes a main

housing (50, Fig. 2) having a visual display window (51, Fig. 2) and a card data entry slot (52,

Fig. 2) used for inserting a conventional or special data-containing card (e.g., a swipe card) into

the entry slot and moving it laterally (see: column 7, lines 17-37). In addition, Cummings, Jr.

teaches that after a card is swiped (101, Fig. 5) and the charges to the patient are in agreement,

the System processor calculates any patient co-pay and/or deductible (140, Fig. 6) and payment

is transmitted to provider account (204, Fig. 8) (see: column 12, lines 22-32 and column 13, lines

41-58).   Therefore, the proper combination of Kraft and Kaufman's dispensing system

communicating data for accounting and billing purposes such as charging an account associated

with a patient with Cummings, Jr. card data entry slot which is card reading device connected to

a computer to read a credit or debit card to charge the patient arrives at Appellant claimed

limitation.

Response to Arguments (P)

Appellant's allegation that the applied reference fails to teach the claimed limitation of

claims 33, 40 and 41 is respectfully submitted to be without merit. In particular, the Examiner

respectfully submits that Kraft et al., Kaufman et al. and/or Cummings, Jr. reference teaches the

disputed feature. Note, for example, column 8, lines 30-37 and column 9, lines 17-25 (claims 33,

40 and 41) of Kaufman, column 2, lines 22-29 (claims 33, 40 and 41) of Kraft, column 7, lines

17-37, column 12, lines 22-32 and column 13, lines 41-58 (claims 33, 40 and 41) of Cummings,

Jr. Appellant's allegations that the Kraft et al., Kaufman et al. and/or Cummings, Jr. references

fail to teach the aformention feature are merely conclusory, are not supported by any evidence

provided by Appellant which clearly and definitely call into question the cited passages of the

applied reference. Appellant has apparently failed to provide any reasonable analysis of the

applied reference. Thus, it is respectfully submitted that Appellant's conclusions cannot take the

place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*,

52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193

USPQ 17 (CCPA 1977).

Response to Arguments (Q)

In response to this argument, the Examiner respectfully submits that one cannot show

nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re

Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for

obviousness is not whether the features of a secondary reference may be bodily incorporated into

the structure of the primary reference; nor is it that the claimed invention must be expressly

suggested in any one or all of the references. Rather, the test is what the combined teachings of

the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, it has been held that a prior art reference must either be in the field of

Appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which

the Appellant was concerned, in order to be relied upon as a basis for rejection of the claimed

invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Firstly, the Examiner respectfully submits that the prior art references are in the field of

Appellant's endeavor. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Appellant's invention pertains to a computer system for displaying targeted healthcare

advertisement to a computer user. The Examiner respectfully submits in this case that the

primary reference, Kraft et al. was relied upon for teachings the storing of information

concerning a patient's medication requirements on the pharmacy system (14, Fig. 1) that

maintains a database of the medication, the manufacturer, the brand name, the generic name, the

dosage form, the location of the drug in the pharmacy, and pricing information (see: column 1,

lines 29-34 and column 4, lines 56-59). Kraft et al. also teaches a dispensing process where a

nurse using a keyboard (28, Fig. 2) enters commands through the system controller (34, Fig. 3)

for orders of all or part of the authorized medication for each of the nurse's patients for a given

medication round and the medication dispenser (12, Fig. 1) retrieves each medication from its

respective container and dispenses the medication (see: column 4, lines 54-65). In addition, Kraft

et al. teaches that the system controller (34, Fig. 3) communicates accounting information for bill

purposes as the medication is dispensed and the information concerning the quantity and type of

medication dispensed for each is patient is communicated to the pharmacy system (see: column

5, lines 47-55). Moreover, Kraft et al teaches a vision subsystem (44, Fig. 4) comprises two optic

systems for comparing specific medication in order to verify that the correct medication is being

dispensed (see: column 7, lines 26-34). Kaufman et al. is relied on for teachings an interactive

patient assistance and delivery system that includes a system (200, Fig. 11) for storing and

delivering of individual pills or caplets as well as both external and internal devices (55, Fig. 5)

for receiving input from the physician (or healthcare professional at the central monitoring

facility 28, Fig. 4a), the individual patient, the physical testing devices (34, Fig. 4a) and (36, Fig.

4a) and the environmental sensors (23, Fig. 8a) and (25, Fig. 8a) in order to gain access to the

medication delivery system (20, Fig. 5) (see: column 8, lines 15-23, column 17, lines 1-22 and

Fig. 11-13). Cummings, Jr. is relied on for teachings a fully integrated and comprehensive health

care system with a terminal that includes a main housing (50, Fig. 2) having a visual display

window (51, Fig. 2) and a card data entry slot (52, Fig. 2) used for inserting a conventional or

special data-containing card (e.g., a swipe card) into the entry slot and moving it laterally (see:

column 7, lines 17-37). Cummings, Jr. further teaches after a card is swiped (101, Fig. 5) and the

charges to the patient are in agreement the System processor calculates any patient co-pay and/or

deductible (140, Fig. 6) and payment is transmitted to provider account (204, Fig. 8) (see:

column 12, lines 22-32 and column 13, lines 41-58). Thus, it is the position of the Examiner that

Kraft et al. Kaufman et al. and Cummings, Jr. are in the field of the Appellant's endeavor (i.e.,

they relate to storing and verifying data representative of medical item (Kraft et al.), receiving

from a patient a request to dispense the medical item (Kaufman et al.) and reading a credit or

debit card with a card reader device (Cummings, Jr.)), and are therefore analogous art.

Secondly, the Examiner respectfully submits that the prior art references are reasonably

pertinent to the particular problem with which the Appellant was concerned. See *In re Oetiker*,

977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Kraft et al. Kaufman et al. and Cummings, Jr.

are directed to solving the problem of storing and verifying data representative of medical item

and receiving from a patient a request to dispense the medical item after reading a credit or debit

card with a card reader device (see: Kraft et al.: column 1, lines 29-34, column 4, lines 56-59 and

column 7, lines 26-34, Kaufman et al.: column 8, lines 15-23, column 17, lines 1-22 and Fig. 11-

13, and Cummings, Jr. et al. column 7, lines 17-37, column 12, lines 22-32 and column 13, lines

41-58). The present application also seeks to solve a similar problem, namely, monitoring and

dispensing medical items in hospital or clinic environments that can more accurately monitor

inventories dispense medical items and correlate the use of medical items with the patient (see:

page 4, lines 3-6 of specification). Thus, it is the position of the Examiner that the prior art references are reasonably pertinent to the particular problem with which the Appellant was concerned and the applied references are analogous art as they all relate to monitoring and dispensing medical items to a patient.

For the above reasons, it is believed that the rejections should be sustained.
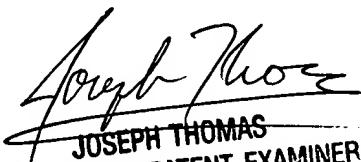
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